

Appl. No. 10/622,237
Amdt. dated April 20, 2005
Response to Not. Of Non-Compliant Amdt.

Via Facsimile - (703) 872-9306
MAIL STOP AMENDMENT
18 pages

3. Remarks

Presently, claims 18-20 are pending with claim 18 being in independent form. Claims 2-17 have been previously cancelled. Applicants have amended claims 18 and 20 and cancelled claims 1 and 19. Applicants have added claims 21-23.

Claims 18 and 20 have been amended to specify that the antibodies specifically bind SEQ ID NO:2 or 4, respectively.

Applicants have added claims 21-23. Claims 21 and 23 specify that the antibodies of claims 18 and 22, respectively, are monoclonal antibodies. Support for monoclonal antibodies may be found in Example 10 at page 25. Claim 22 specifies that the antibody of claim 18 specifically binds to the extracellular domain of SEQ ID NO:2, wherein the extracellular domain comprises amino acids 39 to 374 of SEQ ID NO:2. Support for the extracellular domain consisting essentially of amino acids 39 to 374 of SEQ ID NO:2 may be found, for example, at page 3, lines 28-37. Applicants note that one of skill in the art at the time of Applicants' earliest effective filing date would readily appreciate that antibodies raised to the extracellular domain of proteins was a known technique.

35 U.S.C. §112, first and second paragraph

Claim 18 stands rejected under 35 U.S.C. §112, first and second paragraph. In response, claim 18 has been amended to read: "A composition, comprising an isolated antibody that specifically binds to SEQ ID NO:2." as suggested by the Examiner. Claim 20 has also been amended similarly. Applicants submit that the present claims, as amended, fully satisfy the requirements of 35 U.S.C. §112, first and second paragraph and ask that the rejections be withdrawn.

35 U.S.C. §102

Claims 18-20 stand rejected under 35 U.S.C. §102(e1) and (e2) as being anticipated by U.S. Patent Appln. Pub. No. 2002/0198147 and USPN 6,642,360, respectively. The Examiner states that the prior art teaches antibodies that bind to the PRO355 polypeptide (SEQ ID NO:61), which shares 99.1% identity with Applicants' SEQ ID NO:2. The Examiner notes that Applicants' SEQ ID NO:4 shares 97.8% identity with the PRO355 protein sequence. Based on the percent identity between Applicants' protein sequences and the PRO355 sequence, the Examiner believes that the antibodies taught in the prior art (and claimed in U.S. Patent Appln. Pub. No. 2002/0198147) are the same antibodies that Applicants are now claiming. Applicants respectfully disagree.

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Applicants submit that USPN 6,642,360 and U.S. Patent Appln. Pub. No. 2002/0198147 are not prior art because Applicants' date of invention antedates the earliest effective filing date of the references. As evidence, Applicants submit the enclosed Declaration under 37 CFR §1.131, which shows that Applicants were in possession of SEQ ID NO:2 and 4 prior to December 3, 1997, which is prior to the earliest effective filing date for either of the cited references. Consequently, USPN 6,642,360 is not prior art and the rejection under 35 U.S.C. §102(e2) may be properly withdrawn.

As to the rejection under 35 U.S.C. §102(e1) that U.S. Patent Appln. Pub. No. 2002/0198147 anticipates the present claims, Applicants reiterate that U.S. Patent Appln. Pub. No. 2002/0198147 is not prior art to the present application because Applicants' date of invention is prior to the earliest effective filing date of the reference (*i.e.*, December 3, 1997). Applicants note that U.S. Patent Appln. Pub. No. 2002/0198147 has been abandoned and therefore obviates the need for declaring an Interference proceeding.

Applicants kindly request reconsideration and allowance of the claims. If any outstanding issues remain that may be easily reconciled, the Examiner is invited to telephone Applicants' representative at the number provided below.

Respectfully submitted,

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I hereby certify that this correspondence is being facsimile transmitted to: Mail Stop Amendment, United States Patent and Trademark Office on the date indicated below.

Signed: Nanci M. Kertson
 Nanci M. Kertson

Date: April 20, 2005